

REMARKS

In response to the Office Action, Applicants have cancelled claims 1-32 and added new claims 33-52. Support for claim 33 may be found, for example, on page 28, lines 13-16, page 32, lines 10-15 and original claims 1 and 7. Support for claim 34 may be found, for example, on page 34, lines 8-13. Support for claim 35 may be found, for example, on page 17, lines 21-25. Support for claim 36 may be found, for example, on page 16, line 23-page 17, line 6; page 32, lines 10-20 and page 34, lines 4-7. Support for claim 37 may be found, for example, on page 6, lines 8-15. Support for claim 38 may be found, for example, on page 18, line 11- page 19, line 18. Support for claim 39 may be found, for example, on page 16, lines 6-13. Support for claim 40 may be found, for example, on page 19, lines 23-25. Support for claim 41 may be found, for example, on page 24, lines 19-24. Support for claim 42 may be found, for example, on page 32, lines 6-9. Support for claim 43 may be found, for example, on page 24, lines 9-18. Support for claims 44-45 may be found, for example, on page 17, lines 21-25. Support for claims 46-47 may be found, for example, on page 28, line 18-page 29, line 22. Support for claim 48 may be found, for example, on page 20, line 17-page 21, line 8. Support for claim 49 may be found, for example, on page 26, lines 9-12. Support for claim 50 may be found, for example, on page 32, lines 10-15, page 28, lines 11-16 and original claims 1 and 7. Support for claim 51 may be found, for example, on page 32, lines 10-15 and page 34, lines 6-7. Support for claim 52 may be found, for example, on page 28, lines 13-16; page 32, lines 10-15 and page 17, lines 21-25. No new matter has been added.

Furthermore, Applicants have amended the Title of the Invention to more clearly define the intended subject matter of the present invention. Applicants have also amended the Abstract of the Disclosure to conform to conventions described in MPEP § 608.01(b).

As all pending claims that were rejected in the August 1, 2005 Office Action have been cancelled, the rejections are now moot.

For the reasons set forth below, Applicants respectfully submit that all pending claims are patentable over the cited prior art of record.

II. New Claim 33

Claim 33 recites, in-part, a circuit substrate comprising a substrate including a first surface and a second surface opposite to the first surface; a first conductor pattern formed on the first surface; and a second conductor pattern formed on the second surface, wherein if the substrate is mounted to a second substrate, the second surface is the surface mounted on said second substrate, and the second surface has larger surface roughness than the first surface.

In contrast to the present invention, Hamzehdoost (U.S. 5,689,091) discloses that the packaging substrate has a substrate, a first conductor pattern formed on the substrate, and a second conductor pattern formed on the opposite side of the substrate. However, Hamzehdoost fails to disclose a difference in surface roughness between the two surfaces of the substrate.

Muyshondt (U.S. 5,646,368) discloses that the surface roughness of the surface on one side is greater than that on the other side. However, Muyshondt fails to disclose which side of the surface of the circuit substrate is mounted when a circuit substrate is mounted on another substrate.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggest the desirability of the combination. *In re Mills*, 16, USPQ2d 1430 (Fed. Cir. 1990). In the instant case, nowhere does prior art suggest the

desirability of the combination for any technical purpose. Neither Muyschondt nor Hamzehdoost suggest any benefits or advantages of providing the circuit board of Hamzehdoost with a surface roughness of the circuit substrate made larger on a printing surface of the second conductor pattern than on a printing surface of the first conductor pattern, as taught by Muyschondt.

Furthermore, a statement that modifications of the prior art to meet the claimed invention would have been obvious because the references relied upon teach all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

In the instant case, even assuming *arguendo* that Hamzehdoost and Muyschondt “teach that all aspects of the claimed invention are individually known in the art”, it is submitted that such a conclusion “is not sufficient to establish a *prima facie* case of obviousness” because there is no objective reason on the record to combine the teachings of the cited prior art. Accordingly, Applicants respectfully submit that claim 33, and all pending claims dependent thereon, are allowable.

III. Conclusion

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication of which is respectfully solicited.

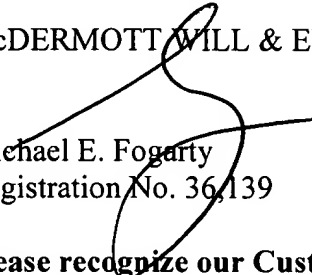
To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

Application No.: 09/661,281

including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP


Michael E. Fogarty
Registration No. 36,139

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8372 MEF/NDM:kap
Facsimile: 202.756.8087
Date: November 1, 2005

**Please recognize our Customer No. 20277
as our correspondence address.**